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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,419	03/01/2002	Dieter Dohring	616.95USWO	2940
23552	7590	04/18/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			WATKINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 04/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,419	DOHRING ET AL.	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,6-10,12,15-20 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,6-10,12,15-20 and 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 31-32, 33, 3, 6-10, 12, 19-20, 22-25, 34, 15, 26, 27, 16, 17, 18, 28, 29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where the instant specification supports the 15 to 60 grams per square meter basis weight of the paper, as now claimed, as being the weight after impregnation.

2. Applicant's arguments filed 25 February 2005 regarding the new matter rejection have been fully considered but they are not persuasive.

Applicant argues that the specification in the description of the prior art refers to the impregnation of a sheet and then the incorporation of that sheet into a laminate without specific reference to the sheet being an called an impregnated sheet and that therefore all references to paper in the instant

Art Unit: 1772

specification refer to impregnated paper, and in particular that references to paper having a specific weight basis refer to an impregnated paper. The examiner disagrees with this analysis at least in regard to the weight of the paper. In particular, the paragraph beginning at page 2, line 29 of the specification refers to the weight of the prior art paper and then states that not only the actual weight of the paper has to be taken into account when calculating material usage, but that an increase in paper weight also means an increase in the amount of resin needed to impregnate the paper. The examiner takes this as evidence that the weight of the paper is separate from the weight of the resin used to impregnate the paper.

3. The previous rejection over Jaisle et al. in view of Moroff et al. and Jaisle et al. alone are withdrawn in view of applicant's amendments and arguments.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 1772

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of applicant's admission of the state of the art at page 1, lines 15-20.

Jaisle et al. teaches the formation of a decorative laminate using an acrylic resin and a melamine resin and abrasive particles (col. 2, lines 55-65), that are pressed and impregnated into the décor sheet of a core (carrier) and décor sheet laminate by a belt press or other means (col. 7, lines 25-35, col. 5, lines 20-35). The weight of the paper in the décor sheet can be between 16 and 160 grams per square meter (col. 4, lines 35-40). Applicant admits that tiles are formed by decorative overlays on core or carrier layers and that counter pull layers are conventional to counter balance the decorative décor layer. The instant invention claims an acrylate resin impregnated into a décor layer, which is used to form a tile laminate with the impregnated paper having a weight between 15 and 60 grams per square meter. It would have been obvious to one of ordinary skill of the art to have added a counter pull layer to the core and décor layer of Jaisle et al. in order to

Art Unit: 1772

stabilize the decorative laminate in view of applicant's admission. It further would have been obvious to select a paper weight in the lower range of the 16 to 160 gram range taught by the reference and impregnate it with up to 30 to 45 weight percent of resin based on the weight of the paper because of the teachings of the reference to impregnate with that amount of resin (col.4, lines 60-65, col. 4, lines 10-15). A 16 gram per square meter paper impregnated with 30 weight percent resin based on the weight of the paper would yield an impregnated paper of about 21-22 grams per square meter. This would be within applicant's argued claim limitation of 15 to 60 grams per meter of impregnated paper.

6. Claims 34, 15, 26, 27, 16, 17, 18, 28, 29, 30 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of applicant's admission of the state of the art at page 1, lines 15-20 as applied to claims 31-32 above, further in view of Mehta (U.S. 5,213,883).

Jaisle et al. teaches the use of pigmented paper that is then impregnated with resin (col. 4, lines 35-40). Mehta teaches the use of titanium dioxide as a pigment which renders a décor paper opaque col. 1, lines 55-65). The instant invention

Art Unit: 1772

claims a titanium dioxide pigment impregnated into a décor sheet with acrylic resin. It would have been obvious to one of ordinary skill of the art to have used titanium dioxide as the specific pigment in the paper of Jaisle et al. in order to make the paper opaque because of the teachings of Mehta.

7. Claims 33, 3, 6, 7, 8, 9, 10, 19, 20, 22, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaisle et al. (U.S. 4,473,613) in view of applicant's admission of the state of the art at page 1, lines 15-20, further in view of Mehta (U.S. 5,213,88) as applied to claims 31-32, 34, 15, 26, 27, 16, 17, 18, 28, 29, 30 and 12 above, and further in view of Koutitonsky et al. (U.S. 5,753,078) and Scher et al. (U.S. 4,093,766).

Koutitonsky et al. teaches the impregnation of a paper with a saturant by the use of a size press that has two rollers that transfer a coating material to a paper that passes through a nip between the two rollers. The pressure of the nip and amount of coating being adjustable to allow for saturation or impregnation of the paper with the coating material. The coating material being distributed on the rollers by the use of a doctor blade (col. 1, lines 15-45). Scher et al. teaches the use of a

Art Unit: 1772

impregnation resin to carry a pigment into a décor paper in order to allow for variation in the degree of pigment level in the paper (col. 4, lines 30-50). The instant invention claims the use of rollers to transfer a coating to a paper used as décor sheet in a tile, the resin impregnating the paper and carrying a pigment into the paper. It would have been obvious to one of ordinary skill in the art to have impregnated the acrylic coating of Jaisle et al. as modified above using nip coating rollers in order to provide good control of the amount of coating because of the teachings of Koutitonsky et al. It further would have been obvious to have added pigment to the resin of Jaisle et al. as modified above in order to have control of the degree of pigmentation because of the teachings of Scher et al.

8. Applicant's arguments filed 25 February 2005 have been fully considered but they are not persuasive.

Applicant argues that the claimed impregnated weight of paper is not taught by Jaisle et al. This limitation is explicitly addressed in the rejection above. Applicant also argues that there is no teaching of a roller being used to coat the paper or a pigment being in the resin. These limitations

Art Unit: 1772

are addressed in the new grounds of rejection given above. The instant impregnated paper is not claimed as having any specific tear resistance and is thus taken as having a similar tear resistance to that of the paper of Jaisle et al. that is impregnated with a similar resin.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/980,419

Page 9

Art Unit: 1772

WW/ww

April 13, 2005

A handwritten signature in black ink, appearing to read "William P. Watkins III". The signature is fluid and cursive, with a prominent "W" and "P" at the beginning and a stylized "III" at the end.

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**